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In re Application of:

PELLERIN, DANIEL

Serial No.: 09/771,416

Filed: Jan. 26, 2001

Docket: 13493

Title: UNIVERSAL CLEAT

DECISION ON PETITION

This is a decision on the petition filed on Oct. 10, 2006 seeking reversal of the objection to the specification for containing new matter. The petition is being considered pursuant to 37 CFR 1.181.

The petition is **DISMISSED**.

In the petition, the petitioner requests a review of the examiner's objection to the specification under 35 USC 132 for introducing new matter into the disclosure. The examiner objected to the disclosure because the newly included limitation "has a generally isosceles and/or equilaterally triangular shaped recess formed about the receptacle" was not supported by the original disclosure. Petitioner believes that the objection to the specification is in error and requests review and relief therefrom.

The record shows that:

- 1) On Jul. 13, 2004, the examiner issued a final Office action. In the final Office action, the examiner rejected claims 10-26 under 35 USC 112 1st paragraph because the subject matter added to the claims in the amendment filed Apr. 15, 2004 included new matter. Specifically, the examiner stated that the following limitations constituted new matter: "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" in claims 10-11; "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses" in claim 15; "with a longest side being shorter than the longest of any of said straight line sides of the recesses" in claim 18; "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" in claim 19; and "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" in claim 23. In addition, the examiner objected to

- the specification under 35 USC 132 because the phrase “has a generally isosceles and/or equilaterally triangular shape recess formed about the receptacle” added in an amendment filed May 20, 2003 was not supported by the original disclosure.
- 2) On Nov. 17, 2004, the petitioner filed an after final amendment under 37 CFR 1.116.
 - 3) On Feb. 2, 2005, the examiner denied entry of the after final amendment filed Nov. 17, 2004 and reopened prosecution of the application by issuing a new non-final Office action. The examiner discovered new references and reopened prosecution to reject previously allowable claims 4-7 and 9. The examiner repeated the 35 USC 112 1st paragraph rejection of claims 10-26 and the objection under 35 USC 132 of the specification.
 - 4) On Aug. 4, 2005, the petitioner filed an amendment to the claims and argued that the features added in claims 10-26 and added to the specification amendment were fully supported by the original drawings.
 - 5) On Oct. 20, 2005, the examiner issued a final Office action and maintained the new matter rejection of claims 10-26 under 35 USC 112 1st paragraph. Included in the 35 USC 112 1st paragraph rejection was a rejection addressing newly presented limitation “one piece molded plastic” which was added to claim 10 in the amendment filed Oct. 20, 2005. The examiner stated that this limitation also constituted new matter. In addition, the examiner maintained the objection under 35 USC 132 because the amendment to the specification filed May 20, 2003 included new matter added to the disclosure.
 - 6) On Oct. 10, 2006, the petitioner filed the current petition requesting reversal of the objection to the specification for containing new matter

Discussion and Analysis

37 CFR 41.31(a)(1) states:

Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

37 CFR 1.181(a)(1) states:

Petition may be taken to the Director: From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination preceding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

MPEP 2163.06 Relationship of Written Description Requirement to New Matter, states:

II. REVIEW OF NEW MATTER OBJECTIONS AND/OR REJECTIONS

A rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.

A review of the entire record of the application reveals that the petitioner and the examiner have arrived at a clear issue with respect to whether the limitations added to claims 10-26 constitute new matter or not. The examiner's position is that the original disclosure does not support the limitations presented in claims 10-26 and therefore constitutes new matter under 35 USC 112 1st

paragraph. The petitioner's position is that claims 10-26 are clearly supported by the original drawing figures. On page 1 of the petition, petitioner seeks to "... exercise the Commissioner's supervisory authority to require the examiner to recognize the drawings submitted with a patent application constitute a portion of the disclosure of the patent application and that such drawings constituting a portion of the disclosure may be used as a basis, in whole or in part, for claims in the patent application." [emphasis added]. In addition, petitioner argues on pages 8-10 of the petition that "... the drawings constitute a part of the disclosure of the subject matter to which a patent application is directed and hence that the drawings can serve as a basis for claims in the application, whether those claims filed with the application or added to the application during prosecution, the law is well established and uniformly supportive of that position.", "... which may be used to support new claims and claim amendments during the course of prosecution of the application.", and "This error continues to deprive applicant of the right to solicit claims using the description of the structure shown in Figures 8 through 11 to define the environment in which the baseball cleat subject matter of the invention functions." [emphasis added].

Applying the plain language of 37 CFR 1.181(a)(1), it is clear that petitioner's arguments will not support the requested relief, because the relief requested is simply not the type of relief that can be obtained by petition. The issues presented by petitioner are clearly directed to the propriety of the examiner's rejection of the claims under 35 USC 112 1st paragraph. The question of whether the claims should be rejected under 35 USC 112 1st paragraph or not is clearly an appealable issue under 37 CFR 41.31(a)(1).

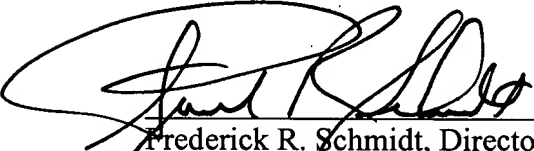
Petitioner also requests relief from the objection to the specification under 35 USC 132 because petitioner believes the phrase "has a generally isosceles and/or equilaterally triangular shape recess formed about the receptacle" added in an amendment filed May 20, 2003, is fully supported by the original drawing figures. However, in view of MPEP 2163.06, if both the claims and specification contain new matter either directly or indirectly, and there has been both rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition. In the instant application, both the claims and specification contain new matter directly. Petitioner's position is that the claim amendments and specification amendments are fully supported by original drawing figures 8-11. The amendments to the claims describe the purported triangular shape of the recess shown in the drawings. The amendments to the specification also describe the purported triangular shape of the recess shown in the drawings. The examiner has issue with the way the recesses are described in both the claims and the specification. Because there has been both a new matter rejection and objection, the issue becomes appealable and should not be decided by petition. Therefore, the relief requested by petitioner cannot be granted by petition.

Conclusion

For the foregoing reasons, the relief requested by the petitioner will not be granted. Because there is both a rejection under 35 USC 112 1st paragraph for new matter and an objection to the specification under 35 USC 132 for new matter, the issue becomes an appealable one and will not be decided by petition.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3728 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

PETITION DISMISSED



Frederick R. Schmidt, Director
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